Remarks

The Office Action dated January 5, 2007 has been carefully considered. By present amendment, claim 1 is amended to reflect that the desired benefits of the present methods are realizable on shoes comprising natural leather surfaces (page 10, lines 28-31) and to reflect teachings in the specification found, for example, on page 10, lines 23-27, page 17, lines 10-13 (Ca/Mg binding w/o removing chromium). New claim 119 is added to capture the specific embodiment disclosed on page 95, lines 28-33. As no new matter is involved, entry of the amendment is believed warranted and is therefore respectfully requested. This Amendment, taken with these Remarks is believed to establish patentability of the claims over the asserted references and allowance is therefore respectfully requested.

Claims 76 - 119 are currently pending, with claims 76, 83-93 and 119 subject to examination.

Nonstatutory Double Patenting

Claims 76, 83-86 and 89-93 are rejected on the grounds of nonstatutory double patenting over claims 1, 2, 9-13 of U.S. Patent No. 6,866,888.

Claims 87-88 are rejected on the grounds of nonstatutory obviousness-type as being unpatentable over claims 1, 2, 9-13 of U.S. Patent No. 6,866,888 in view of Watanabe.

Claims 76 and 83-93 are provisionally rejected on the grounds of nonstatutory double patenting over claims 1-3, 5-6, 12, 14, 18, 22-23, and 25-29 of co-pending Application No. 10/862,707.

Submitted herewith is a Statement of Common Ownership establishing the common ownership of the present application, U.S. Patent No. 6,866,888, and co-pending U.S. Application Serial No. 10/862,707, and a Terminal Disclaimer disclaiming the terminal portion of the patent term of any patent which issues from the present application, extending beyond the patent term of the '888 patent, or any patent which issues from the co-pending Application, subject to the conditions and terms stated therein. Applicants submit that these submissions overcome the nonstatutory double patenting rejections, above. Reconsideration is respectfully requested.

35 U.S.C. § 102

Claims 76, 83-84, 89 and 93 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,306,435 to Ishikawa. Specifically the Examiner asserts that Ishikawa discloses a method for treating shoes (at column 12, line 36) made from leather, fur and fibrous material with a composition, where the leather, fur and woven, knit and unwoven fabrics made of natural fibers such as animal hair, wool, silk, cotton and the like or their mixed fabrics with synthetic fibers treated with the treating compositions can be washed in water and retain flexibility and excellent dimensional stability. The Examiner further asserts that the reference treating composition comprises surfactants, microbiocide, perfume, pH regulators, and whitening

agents, constituting the benefit agents of the present claim. This rejection is traversed and reconsideration is respectfully requested.

Instant independent claim 76 is directed to a method for treating one or more shoes comprising at least one surface made from natural leather, the method comprising contacting the one or more shoes directly or indirectly with one or more treating compositions, each of which comprises one or more benefit agents that imparts one or more desired benefits to the one or more shoes when the treating composition is applied directly or indirectly to the one or more shoes prior to and/or during and/or after washing the one or more shoes with or in an aqueous medium, wherein said treating composition is formulated to deliver an effective level of a calcium/magnesium removal agent without removing significant levels of chromium from the natural leather so that any damage as a result of washing the one or more shoes with or in an aqueous medium with application of the treating composition is reduced compared to washing the one or more shoes with or in an aqueous medium without application of the treating composition.

Ishikawa, on the other hand, is directed to methods and treatment compositions intended to be applied to *RAW* substrates only intended for manufacture into articles (column 12, lines 5-17, e.g.). The Ishikawa invention provides treatments for raw leather and fur to improve water absorption, dimensional stability and shrink resistance of the raw material from which articles may be hewn. The leather/fur is treated according to the Ishikawa methods and compositions in its raw form, and is thereafter made into downstream articles such as, for example, shoes. Contrary to the Examiner's contentions, Applicants respectfully submit that Ishikawa simply does not disclose any methods related to treating the downstream articles, including shoes. The portion of Ishikawa cited for this proposition is found at column 12 wherein it is disclosed that "a leather having been treated with the treating agent of the invention...is widely usable as clothings [sic], underwares [sic], helmet leather, back skin and gloves, as well as squeeze-formed articles made from single leather sheet such as shoes, trunk, bag, box, hat, slipper, sock cover and the like, leather paper..." Applicants submit that this text cannot be construed as saying that there is any benefit or utility whatsoever to treating the actual article according to the methods of Ishikawa. For example, leather that has already been sewn into a garment has been subjected to conditions of temperature and dryness, and for which a pre-determined "size" has already been ascribed based on the characteristics of the substrate leather. Treating this article according to the methods of Ishikawa, which may alter the appearance and absorbability, expand the leather or hydrate the leather after incorporation into a sized article, sewn with threads or otherwise fixed into shape and size, would be undesirable.

The only conventional "washing" disclosed in Ishikawa involves various comparative examples of washing treated leather samples, *not articles of manufacture*, and testing for physical characteristics such as tear strength, thickness, elongation, etc.(see Table 2). There is no teaching or suggestion of treating downstream articles and no disclosure of treatment compositions directed to cleaning downstream articles, including shoes. Surely the Examiner is not suggesting the analogous situation where a disclosure directed to inventive methods and compositions for treating sheet metallic substrates intended for manufacturing purposes is considered equivalent to a disclosure of inventions directed to treating/cleaning, for example, automobiles or airplanes manufactured therefrom.

Regardless of this, Applicants submit that the methods of Ishikawa do not include application of compositions (to shoes or otherwise) formulated for effective delivery of Ca/Mg removal agents without removing significant amounts of the chromium in the leather portion of the shoe (or leather substrate), as required by present independent claim 76. .

Anticipation under 35 U.S.C. § 102(b) requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986).To serve as an anticipating reference, the reference must enable that which it is asserted to anticipate. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). Ishikawa fails to teach methods for treating shoes and fails teach methods comprising, inter alia, application of compositions formulated to achieve effective delivery of Ca/Mg removal agents without removing significant levels of chromium from the natural leather, as required by the instant claims. Hence, Ishikawa cannot anticipate the present claims and the rejection of claims 76, 83-84, 89 and 93 under 35 U.S.C. § 102 under Ishikawa is overcome. Reconsideration is therefore respectfully requested.

35 U.S.C. § 103

Claims 76, 83-87 and 89-93 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,837,670 to Hartshorn ("Hartshorn") in view of U.S. Patent No. 5,749,924 to Murch ("Murch '924"). Specifically, the Examiner asserts that Hartshorn discloses a cleaning composition for pre-treating stained fabrics or laundry comprising surfactants, disinfecting agents such as peroxygen bleaches, builders, brightening agents and soil release agents in referenced amounts and states that fabrics may obviously be machine washed. The Examiner notes that Hartshorn does not expressly disclose use of the cleaning composition for treating shoes, but asserts that Murch discloses the spot-treating of shoes with a composition that is then removed during wash so that it would have been obvious to use a detergent composition for pre-treating stained fabrics in Hartshorn in any form including shoes. The Examiner asserts that the ranges of benefit agents disclosed by Hartshorn would provide the claimed benefit since they assertedly reflect ranges disclosed in the present specification. This rejection is traversed and reconsideration is respectfully requested.

Instant claim 76 is set forth in detail, above. Notably, the present inventive method requires application of compositions formulated to, inter alia, deliver Ca/Mg removal agents, as disclosed on page 15, lines 26-37 of the specification. As disclosed therein, Applicants note that such agents are particularly desirable for cleaning the type of soils associated with shoes, as distinct from other leather garments which would not normally require these agents to achieve effective cleaning (page 16, lines 1-5). However, as Applicants further disclose, such agents are problematic to leather because they typically bind and remove transition metals, such as chromium, which imparts strength and temperature resistance to leather (page 17, lines 3-5). The present inventive methods uniquely seek to deliver Ca/Mg removal agents while preserving the chromium in the leather portion of the treated shoes. Effective methods for achieving this balance are presently disclosed, including, for example, using high concentrations of weakly

binding Ca/Mg removal agents in direct applications, and/or using large molecular weight Ca/Mg removal agents that cannot penetrate and diffuse into dense leather materials (id).

Hartshorn is directed to conventional detergent compositions having agents effective for achieving suds suppression desired in some cleaning applications. Hartshorn fails to teach or suggest methods comprising formulation of compositions effective for delivery of Ca/Mg removal agents, and fails to recognize or address the issue of the undesirable common side effect of such agents in removing Cr from leather and the problems relating thereto, that motivate in part the present inventive methods. The secondary reference, Murch '924 is primarily directed to cleaning compositions for cleaning fruits and vegetables but suggests application to inanimate objects such as, for example, shoes. However, Murch '924 fails to teach or suggest methods comprising application of compositions formulated for delivery of Ca/Mg removal agents while preserving chromium contained in the treated leather portion of a shoe. Hence, Murch does not overcome the deficiencies of the primary reference and the combination of Harshorn in view of Murch does not establish a prima facie case of obviousness.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The combination of Hartshorn in view of Murch '924 fails to teach or suggest methods for treating shoes comprising, inter alia, application of compositions formulated for the delivery of Ca/Mg removal agents that do not remove a significant amount of the Chromium present in the treated leather portion of the shoe, as required by instant independent claim 76. Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987). Hence, the rejection of claim 76, 83-87 and 89-93 under 35 U.S.C. §103 as being unpatentable over Hartshorn in view of Murch is overcome. Reconsideration is respectfully requested.

Claims 76, 83-87 and 90-93 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. H1513 to Murch ("Murch '513) in view of Murch '924. Specifically, the Examiner asserts that Murch '513 discloses a method for removing soils and stains from fabrics comprising contacting the fabric with a laundry detergent composition with agitation and that the detergent comprises various benefit agents, including, inter alia, polyphosphates (column 7, line 33) and peroxygen bleaches (column 12, line 55), but that Murch does not expressly teach that the cleaning composition may be used for treating shoes. Much '924 is applied for the reasons stated above such that the combination for treating shoes would be obvious. This rejection is traversed and reconsideration is respectfully requested.

The recitation of independent claim 76 is set forth in detail above, but in relevant part is directed to a method for treating shoes requiring application of a composition free of polyphosphates and formulated to deliver an effective level of a calcium/magnesium removal agent without removing significant levels of chromium from the natural leather portion of the shoes. Such formulation manipulations to achieve this are disclosed, for example, on page 17 and18 of the instant specification.

Murch '513, on the other hand, is directed to general detersive compositions employing certain nonionic surfactants with oleoyl sarcosinate. Murch '513 is not concerned with the problems unique to treating or cleaning shoes and does not teach or suggest methods comprising application of compositions formulated to deliver Ca/Mg removal agents as required by instant claim 76. In fact, Murch teaches away from the present invention by disclosing that inclusion of "calcium and/or magnesium ions" in the finished compositions is *desirable* in order to stabilize desired enzyme ingredients (column 11, lines 25-30). Murch '513 sets forth 12 specific examples illustrating the Murch invention, none of which lists Ca/Mg removal agents as ingredients, and Murch '513 fails to recognize or address the issue of preservation of chromium in leather incorporated into shoes, as presently addressed by the inventive methods. Murch '924, as noted above, is primarily directed to compositions effective for cleaning fruits and vegetables, but does suggest that application of the compositions to certain inanimate objects, including shoes, may be useful. Murch '924, however, also fails to recognize or address the unique problems associated with treating shoes having leather portions, does not teach or suggest inclusion of Ca/Mg removal agents without removing substantial amounts of chromium from the leather, and therefore does not overcome the deficiencies of the primary reference. The combination of Murch '513 and Murch '924 fails to establish a prima facie case of obviousness.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d at 981. The combination of Murch '513 and Murch '924 fails to teach or suggest methods for treating shoes comprising application of compositions formulated to deliver Ca/Mg removal agents while preserving Chromium in the leather portions of the treated shoes, as required by instant independent claim 76. Hence, the rejection of claims 76, 83-87 and 90-93 under 35 U.S.C. § 103 as being unpatentable under Murch '513 in view of Murch '924 is overcome and reconsideration is respectfully requested.

Claims 85-87 are rejected under 35 U.S.C. § 103 as being unpatentable over Ishikawa in view of Hartshorn. Specifically, the Examiner applies Ishikawa as above, but notes that Ishikawa fails to teach a cleaning composition applied in the wash cycle of a washing machine or in the form of a gel, but that Hartshorn teaches that a cleaning composition can be formulated for pre-treating stained fabrics for laundry machine washing. This rejection is traversed and reconsideration is respectfully requested.

Claims 85-87 depend from instant independent claim 76. As noted above in the section 102 rejection argument on the basis of Ishikawa, Ishikawa fails to teach *or suggest* methods for cleaning shoes, and fails to teach *or suggest* methods for treating any substrate that include, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents while preserving Chromium in the leather. Hartshorn, also discussed above, is directed to suds-suppression in conventional detersive compositions and fails to recognize or address the problems unique to cleaning shoes, including, as presently disclosed, the desirability of Ca/Mg removal agents in such compositions in tension with their propensity to undesirably remove chromium from the leather portion of treated shoes. The present specification, as noted above, teaches several formulation manipulations designed to achieve the goal of effective removal of Ca/Mg while preserving chromium in the leather. Hence, Hartshorn fails to overcome the deficiency of the primary reference, Ishikawa, with respect to the base claim 76.

Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987). The rejection of claims 85-87, all depending from independent claim 76 under 35 U.S.C. §103 under Ishikawa in view of Hartshorn is therefore overcome. Reconsideration is respectfully requested.

Claims 86-88 are rejected under 35 U.S.C. § 103 as being unpatentable over Ishikawa and Hartshorn in view of Murch '924 and Murch '513, further in view of Watanabe (JP 10276961). The four primary references are applied for the teachings set forth above. Watanabe is applied for disclosure that a detergent may be formulated as a gel and applied by a brush or made into water microparticles and pressurized to be sprayed to a shoe for washing. This rejection is traversed and reconsideration is respectfully requested.

Once again, Applicants note that claims 86-88 depend from base claim 76. Also as noted prior, none of the four primary references, alone or in combination, teach or suggest methods for cleaning shoes comprising, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents while preserving chromium in the leather portion of the shoes. Indeed, one of the references in this combination, Murch '513 teaches addition of Ca and Mg ions in order to stabilize enzyme added to the Murch detersive compositions, which are not intended for treating shoes. The fifth reference, Watanabe, fails to cure this deficiency of the primary references. Hence, a prima facie case of obviousness is not established by this five-way combination for base claim 76. Since dependent claims are nonobvious if the claims from which they depend are nonobvious, the rejection of claims 86-88 as being obvious and unpatentable over Ishikawa, Hartshorn, Murch '513, Murch '924, further in view of Watanabe, is overcome. Reconsideration is respectfully requested.

Claim 89 is rejected under 35 U.S.C. § 103 as being unpatentable over Murch '513 in view of Murch '924, further in view of Hartshorn. Specifically, the Examiner notes that the combination of Much '513 and Murch '924 fails to teach a cleaning composition applied to shoes prior to washing, and applies Hartshorn for its teaching that a cleaning composition can be formulated for pre-treating stained fabrics or laundry machine washing. This rejection is traversed and reconsideration is respectfully requested.

A detailed traversal of the rejection of base claim 76 under Murch '513 in view of Murch '924 is set forth above. Summarily, the combination fails to teach or suggest methods for treating shoes comprising, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents while preserving the chromium contained in the leather surfaces of a shoe. The third reference, Hartshorn, also as noted above, fails to cure this deficiency. Hence, base claim 76, from which claim 89 depends, is nonobvious and patentable over Murch '513 in view of Murch '924 further in view of Hartshorn. Since dependent claims are nonobvious if the claim from which they depend is nonobvious, the rejection of claim 89 under 35 U.S.C. §103 under Murch '513, Murch '924 and Hartshorn is overcome. Reconsideration is respectfully requested.

Claims 90-92 are rejected under 35 U.S.C. §103 as being unpatentable over Ishikawa. Specifically the Examiner notes that Ishikawa is applied for the reasons stated prior, but fails to teach shoes being placed into a flexible bag. The Examiner asserts that it is well known in the art that articles made of delicate fabric should be washed in a flexible bag to prevent damage to the fabric. This rejection is traversed and reconsideration is respectfully requested.

The recitation of base claim 76 is set forth in detail above. In pertinent part, claim 76 is directed to a method of treating shoes having at least one leather surface. The method comprises, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents without binding of the chromium in the leather. As noted above, Ishikawa fails to teach or suggest methods for treating shoes, and is directed to treatment of raw leather and other substrates intended for manufacture into various articles, including shoes. Further, Ishikawa fails to teach *or suggest* such methods comprising, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents with retention of significant amounts of the chromium in the leather surface of the shoe. Such agents are known to bind to transition metals, including chromium, which imparts strength and temperature resistance to leather (page 17, lines 3-5). The present specification discloses several formulation manipulations to achieve this desirable balance, including, for example, using high concentrations of weakly binding Ca/Mg removal agents in methods comprising direct applications, and/or using large molecular weight Ca/Mg removal agents that cannot penetrate and diffuse into dense leather materials (id). Hence, base claim 76 is nonobvious and patentable over Ishikawa.

Since dependent claims are nonobvious if the claims from which they depend are nonobvious, claims 90-92 are nonobvious and patentable over Ishikawa and the rejection under 35 U.S.C. § 103 is overcome. Reconsideration is respectfully requested.

Claims 90-92 are rejected under 35 U.S.C. §103 as being unpatentable over Ishikawa and Hartshorn in view of Murch '924 and Murch '513, further in view of Yoshioka. Specifically, the Examiner applies Ishikawa, Hartshorn, Murch '924 and Murch '513 for reasons stated above, and applies Yoshioka for the suggestion that shoes can be washed in flexible bags to prevent damage to the shoes. This rejection is traversed.

As established above, base claim 76 is nonobvious and patentable over the combined teachings of Ishikawa, Hartshorn, Murch '924 and Murch '513 because these references, alone or in combination, fail to teach or suggest methods for treating shoes having at least one leather surface comprising, inter alia, application of compositions formulated for effective delivery of Ca/Mg removal agents without removal of chromium from the leather. The fifth reference, Yoshioka, fails to cure this deficiency. Hence, base claim 76 is nonobvious and patentable over the combination of Ishikawa, Hartshorn, Murch '924, Murch '513, further in view of Yoshioka.

Since dependent claims are nonobvious if the claim from which they depend is nonobvious, the rejection of claims 90-92 under 35 U.S.C. §103 over Ishikawa and Hartshorn, in view of Murch '924 and Murch '513, further in view of Yoshioka is overcome. Reconsideration is respectfully requested.

Conclusion

Applicants believe this is a comprehensive response to the rejections of claims 76 and 83-93 under 35 U.S.C. §§ 102, 103 and nonstatutory double patenting as set forth by the Examiner in the January 5, 2007 office action. Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matters is respectfully solicited.

/Denise M.Everett/
Denise M. Everett
Reg. No. 47,552
Attorney for Applicants
Dinsmore & Shohl LLP
(513) 977-8787

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